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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,264	01/06/2005	Gianantonio Pozzato	66309-207	5092
68804	7590	11/24/2008		
JOHN P. DE LUCA 17420 RYEFIELD CT. DICKERSON, MD 20842			EXAMINER KAHELIN, MICHAEL WILLIAM	
			ART UNIT 3762	PAPER NUMBER
			MAIL DATE 11/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,264	<b>Applicant(s)</b> POZZATO, GIANANTONIO	
	<b>Examiner</b> MICHAEL KAHRELIN	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,7 and 15 is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

### ***Claim Objections***

2. Claims 8, 9, and 14 are objected to because of the following informalities: in claim 8, "comprising" should be deleted after "adherence"; in claim 9, "switich" should read "switch"; and in claim 14, "said electrodes" should read "said one or more electrodes." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taricco (US 2004/0049229, hereinafter "Taricco").
5. In regards to claims 8 and 14, Taricco discloses a device with one or more electrodes (par. 0018); an RF circuit (22 and 24); a rectifier circuit for supplying a voltage (14); said RF circuit comprising an electronic switch fed by said voltage (24); a piloting circuit feeding the switch (22); wherein said RF circuit is capable of producing a distorted sinusoid of about 4MHz and including harmonics of the second and third order

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(par. 0014 and 0016); and a broadband resonant circuit (R3, C3, R4, and 26). Taricco does not expressly disclose that the electrodes are laminar electrodes for application to the skin by adherence. It is well known in the art to provide electrodes in systems similar to Taricco's with an adhesive laminar form factor to provide the predictable results of providing reliable electrical contact while treating maladies of the surface of the skin. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taricco's electrodes by providing an adhesive laminar form factor to provide the predictable results of providing reliable electrical contact while treating maladies of the surface of the skin.

**6.** In regards to claims 11-13, the amplitude is variable based on the regulator/rectified voltage (16; par. 0013; and Fig. 2).

**7.** In regards to claim 9, Taricco discloses the essential features of the claimed invention except for a resonant circuit having the parasitic capacity and inductance of the primary circuit. It is well known in the art to match secondary tank circuits with primary tank circuits to provide efficient power transmissions between the two circuits, while protecting the body from large DC currents. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taricco's invention by matching a secondary tank circuit's capacitance and inductance with the primary tank circuit to provide the predictable result of efficient power transmissions between the two circuits while protecting the body from large DC currents.

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8. In regards to claim 10, Taricco discloses the essential features of the claimed invention including a controller that controls the piloting circuit (28), but does not expressly disclose that a microprocessor provides an amplitude modulated wave. It is well known in the art to modify various pulse generator parameters using a microprocessor to provide an amplitude modulated wave to provide the predictable result of customizable control over a circuit. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taricco's invention by modifying an amplitude modulated wave using a microprocessor to provide the predictable result of customizable control over a circuit. Further, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the system as taught by Taricco with the claimed amplitude modulation strategies because applicant has not disclosed that these provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system as taught by Taricco because both systems effectively treat tissue. Therefore, it would have been an obvious matter of design choice to modify Taricco invention to obtain the invention as specified in the claims.

### ***Response to Amendment***

9. The exhibit filed 2/9/2008 is insufficient to overcome the rejection of claims 8-14 based upon unpredictable results as set forth in the last Office action because: the submission is not in declaration/affidavit form, there is no nexus shown between the results obtained and the specific claim limitations (e.g., the 4MHz stimulation

frequency), and the showing is rendered moot based on a new grounds of rejection, necessitated by amendment.

***Response to Arguments***

10. Applicant's arguments with respect to claims 8-14 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.

***Allowable Subject Matter***

11. Claims 6, 7, and 15 are allowed.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mawhinney (US 6,463,336; previously cited) is one of many teachings of adhesive laminar electrodes.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL KAHELIN whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Kahelin/  
Examiner, Art Unit 3762

/Angela D Sykes/  
Supervisory Patent Examiner, Art Unit 3762